

Remarks

I. Status of the Claims

Claims 1-10, 12, 13, 15-19, and 21-59 are pending in this application. Claims 57 and 58 were withdrawn from consideration by the Examiner. Applicants thank the Examiner for indicating the allowable subject matter of claim 19 and for withdrawing (1) the rejection of claims 1-10, 12, 13, 15-18, 20-25, 46, 47 and 52-56 under 35 U.S.C. § 102(b), and (2) the rejection of claims 12 and 13 under 35 U.S.C. § 112, second paragraph for indefiniteness. Applicants maintain that all the pending claims are patentable, however, in view of the following remarks.

II. Rejections under 35 U.S.C. § 112, first paragraph

The Examiner has maintained the rejection of claims 1-10, 12, 13, 15-18, 21-56 and 59 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement for the reasons of record. Office Action at page 2. In answer to Applicants' arguments in the Response filed July 11, 2005 the Examiner alleged that the "instant specification **does not** provide sufficient information and guidance for one skilled in the art as to what members of the genus of semi-crystalline compounds having the specified transition temperature and water-solubility, other than polycaprolactones, could be used in the instant invention." Office Action at page 3 (emphasis in original).

Applicants respectfully traverse this rejection and maintain that the Examiner has not met the required burden by explaining why a person skilled in the art would not recognize in Applicant's disclosure the claims of the present invention. The specification clearly sets forth the properties of the claimed thermal transition agents. Applicants reiterate that a description as filed is presumed to be adequate, unless or

until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. M.P.E.P. § 2163, III. A. at 2100-176. Here, the Examiner has not set forth express findings of fact regarding the conclusion that the claims lack written description. Specifically, the Examiner still has not set forth why one skilled in the art would not readily know other members of the functionally defined genus of claim 1 other than polycaprolactones.

Finally, the Examiner alleges that it is not clear what the other members of the genus are and invites applicant to “name such compounds, so that the Examiner is able to fully search the entire scope of the claims.” Office Action at page 4. Applicants respectfully assert that naming such compounds is unnecessary as the specification clearly sets forth the properties of the claimed thermal transition agents. Knowing these properties, coupled with the example of polycaprolactones set forth in the specification, would allow other suitable thermal transition agents to be identified. The specification provides the guidance for such a selection.

Accordingly, for at least these reasons and the reasons of records, Applicants request that this ground of rejection be withdrawn.

II. Double Patenting Rejection

The Examiner has maintained the rejection of claims 1-10, 12, 13, 15-18, 21-56 and 59 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1- 30, 32-37, 45 and 46 of copending Application No. 10/138,325, now U.S. Patent No. 6,946,518 (“the ‘518 patent”), for the reasons of record. Office Action at page 2.

Applicants traverse this rejection and respectfully submit that the Examiner has clearly failed to meet the burden of establishing that the present claims would have been obvious over the claims of the '518 patent. Nevertheless, in order to advance prosecution of this application, Applicants have filed concurrently herewith a Terminal Disclaimer over U.S. Patent No. 6,946,518. Accordingly, Applicants request that this ground of rejection be withdrawn.

VI. Conclusion

In view of the foregoing remarks, Applicants respectfully request the reconsideration of this application, and timely allowance of the pending claims. If the Examiner believes a telephone call could be useful in resolving any outstanding issues, she is invited to contact Applicant's undersigned counsel at 202-408-4388.

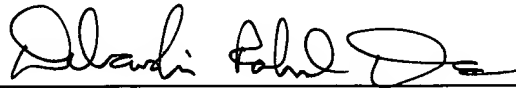
Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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FARABOW, GARRETT & DUNNER, L.L.P.

Dated: March 20, 2005

By: _____



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